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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,100	02/12/2002	Makoto Sakaki	F1866.0002/P002	3712

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EXAMINER
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JENKINS, KIMBERLY YVETTE

ART UNIT	PAPER NUMBER
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2635

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

**Office Action Summary****Application No.**

10/073,100

**Applicant(s)**

SAKAKI, MAKOTO

**Examiner**

Kimberly Jenkins

**Art Unit**

2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A. SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 January 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

DETAILED ACTION

*Response to Amendment*

1. The amendments filed on January 27, 2005 of Application No. 10/173100 have been reviewed by the Examiner. The Examiner acknowledges amended claims 1-14 as disclosed on pp. 3-8, and the correction of indefinite claim language of "type", which has been corrected to "characteristics". In turn, the rejection under 35 U.S.C. § 112 has been withdrawn.

*Response to Arguments*

2. Applicant's arguments, see pp. 8-9, filed January 27, 2005, with respect to the rejections of claims 1-14 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon the further considerations, a new grounds of rejection is made in view of Asakura (US 6460073) and Hill et al. (US 6023714).

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over of Asakura (US 6460073) in view of Hill et al. (US 6023714).

Regarding claims 1 and 8, Asakura, who discloses a method and apparatus for transmitting and receiving electronic mail based upon user availability, teaches an arrival information dealing means for transmitting data arrival information (electronic mail 1) through a

network (col. 4, lines 30-33). Asakura discloses the communication over the optional radio network by way of the mobile telephones (col. 8, lines 38-42). It is well known to one of ordinary skill in the art to know that such cellular phones are capable of receiving email, such as Nextel, Sprint PC, T-Mobile, etc. In addition, Asakura teaches the consideration of each user is taken into consideration, because the users 2-1 to 2-n have their separate identification, which is stored in the user access data memory 30 (col. 4, lines 34-42). Although Asakura discloses the conversion of transmitted data; Asakura does not disclose the content of the received data to result in edited data, and transmitting the edited data to the user terminal.

However, Hill, who teaches a system and method for adapting the layout of a document to an output device, expressively discloses the content of the received data as being edited to the use terminal (col. 4, lines 4-40 and col. 5, lines 55-65). Hill also discloses the invention as being practiced on hand-held devices (col. 4, lines 35-40). It is known to one skilled in the art for such hand-held devices to have format changes/edits, such as personal digital assistant and cellular phones. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the ability to edit/change the format as disclosed in Hill into the networking system of Asakura as a means for the receiving terminal to receive data in compliance with the terminal embodiment and communication system.

Regarding claims 2 and 9, Asakura teaches, as aforementioned, teaches an arrival information dealing means for transmitting data arrival information (electronic mail 1) through a network (col. 4, lines 30-33). In addition, Asakura teaches the consideration of each user is taken into consideration, because the users 2-1 to 2-n have their separate identification, which is stored in the user access data memory 30 (col. 4, lines 34-42). Furthermore, Asakura teaches a receiving means for the reception of the data arrival (read as electronic mail 1) (col. 4, lines 30-

32). Asakura also teaches a terminal (device) type storing means, which is read as a user setting memory portion 3 (col. 4, lines 46-48). Moreover, Asakura teaches a data arrival information type determining means (read as transfer device determining means 60) that determines the appropriate device of the user 2-j from the user setting memory 3 (col. 8, lines 27-33). In turn, the data (electronic mail 1) will be converted (or changed/edited) into a receivable form for the devices before being transmitted to the addresses. The terminal may include a facsimile, a mobile phone, and the mail system 10 (col. 8, lines 34-42). Henceforth, the electronic mail system makes it possible to automatically switch the electronic mail 1 either to transfer or not transfer in accordance to the environment of the user (col. 8, lines 61-64). However, Asakura does not disclose does the content of the received data to result in edited data, and transmitting the edited data to the user terminal.

However, Hill, who teaches a system and method for adapting the layout of a document to an output device, expressively discloses the content of the received data as being edited to the use terminal (col. 4, lines 4-40 and col. 5, lines 55-65). Hill also discloses the invention as being practiced on hand-held devices (col. 4, lines 35-40). It is known to one skilled in the art for such hand-held devices to have format changes/edits, such as personal digital assistant and cellular phones. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the ability to edit/change the format as disclosed in Hill into the networking system of Asakura as a means for the receiving terminal to receive data in compliance with the terminal embodiment and communication system.

Regarding claims 3 and 10, Asakura teaches the mail system 10 to have a means to convert (or edit) the data arrival information to suit the device of which the type of data arrival information to be transferred to the corresponding address (col. 8, lines 38-42).

Regarding claims 4-5 and 11 and 12, Asakura teaches the electronic mail system 10 that transmits and receives arrival data (electronic mail 1) through a network (col. 4, lines 30-33). Asakura, as aforementioned above, teaches that the electronic message can be edited to fit the format of the terminal of reception (col. 8, lines 38-42). The user terminal information is stored within the user setting memory portion 3 (col. 8, lines 32-33). Henceforth, in the event that the data arrival information is to be transmitted to the auxiliary transfer devices (terminals), such as cell phones and facsimiles, the radio network, transfer protocol, and connecting systems are automatically taken into consideration (Asakura demonstrates the concept in col. 8, lines 34-38).

Regarding claims 6 and 13, Asakura teaches as aforementioned regarding claims 2 and 9, also teaches that the data obtaining request can be made by the user(s) 2-1 to 2-j (col. 9, lines 9-13). However, Asakura does not disclose the content of the received data to result in edited data, and transmitting the edited data to the user terminal.

However, Hill, who teaches a system and method for adapting the layout of a document to an output device, expressively discloses the content of the received data as being edited to the use terminal (col. 4, lines 4-40 and col. 5, lines 55-65). Hill also discloses the invention as being practiced on hand-held devices (col. 4, lines 35-40). It is known to one skilled in the art for such hand-held devices to have format changes/edits, such as personal digital assistant and cellular phones. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the ability to edit/change the format as disclosed in Hill into the networking system of Asakura as a means for the receiving terminal to receive data in compliance with the terminal embodiment and communication system.

Regarding claims 7 and 14, Asakura teaches that the terminal type as being read out and stored within the transfer device determining rule memory portion 80, that stores the transfer device (terminal) of each user 2-1 to 2-j to determine the user's location of the terminal as being a "portable terminal" (col. 9, lines 57-65). In turn the terminal information is stored in the event that the user information can be obtain for the appropriate transmission of data.

### *Conclusion*

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Lee et al. (US 6658251) teaches a method and apparatus for designating wireless application protocol (WAP) which converts data and protocols between wireless communication and an internet server.
- Sabani et al. (US 6393296) teaches an email acces from cellular/PCS phones using user agents.
- Griffin et al. (US 6611254) teaches a hand-held device with a keyboard that can be used for wireless communication.
- Pazdersky et al. (US 6546239) teaches a mobile radio telephone with reduced key set.
- Eldridge et al. (US 6487189) teaches a mobile email document transaction service.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kimberly Jenkins whose telephone number is 571.272.3064. The examiner can normally be reached from Monday to Friday between the hours of 7am - 3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 571.272.3068. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Alb...*  
*Pring Ex.*

Kimberly Jenkins  
Examiner  
Art Unit 2635  
23 March 2004

*KYJ*